

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. no. 09/917,880

Claims 1-19 remain pending in the application. Claims 7-11, 15-16 and 19 have been allowed. Claims 3-6, 12 and 18 are deemed to describe allowable subject matter but have been objected to for depending on rejected base claims. Claims 1-2, 13-14 and 17 have been rejected as being anticipated by Eshed (previously of record). Applicant continues to maintain the allowability of independent claim 1, 13 and 17 and their dependent claims.

The Examiner maintains the same basis for rejection and offers points in rebuttal.
Applicant responds as follows:

First, the Examiner contends that Eshed teaches a change in distance between the printing member and light sources and compensation therefor. Even assuming that there is such a compensation, the mechanisms by which Eshed achieves the compensation do not teach all features of Applicant's claim 1. In particular, claim 1 describes movement of the light source towards and away from the medium based on the correction data. The Examiner's reliance on the scanning of a light source in a direction parallel to the medium surface (Fig. 1, direction 2) is clearly not relevant to this recitation. As previously indicated, the compensation for distance errors in Eshed results from lens movements. Light source movement is not taught or suggested. Therefore, claim 1 is patentable, and claim 2 is patentable based on its dependency.

With further regard to claims 13 and 17, these claims also include the movement of the light source as described above for claim 1. Therefore, claims 13 and 17 are patentable for similar reasons. The remaining claims are patentable based on their dependency.

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With further regard to claims 13 and 17, the Examiner's rebuttal acknowledges that a memory is not inherent in device of Eshed. While the Examiner states that a memory is "likely required", the rationale for rejection is a statement of probability. It is well settled that probabilities do not support prior art rejections. In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). The Examiner reasons that the memory would be required to store any "predetermined" distances. Since Eshed is silent as to any predetermined measurements and distance adjustments between the medium and light source, the Examiner is simply fabricating disclosures that do not exist in Eshed. The rejections of claims 13 and 17 remain unsound for this additional reason.

In view of the above, Applicant submits that claims 1-19 are in condition for allowance. Therefore it is respectfully requested that the subject application be passed to issue at the earliest possible time. The Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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